

**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q75250

Chun-Hee SONG

Appln. No.: 10/653,929

Group Art Unit: 3628

Confirmation No.: 4912

Examiner: Daniel VETTER

Filed: September 4, 2003

For: METHOD AND APPARATUS FOR PREVENTING DUPLICATE RECORDING OF A  
BROADCASTING PROGRAM

**AMENDED APPEAL BRIEF UNDER 37 C.F.R. § 41.37**

**MAIL STOP APPEAL BRIEF - PATENTS**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, Appellant submits the following:

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**I. REAL PARTY IN INTEREST**

The real party in interest is SAMSUNG ELECTRONICS CO., LTD., by virtue of an assignment executed by Chun-Hee Song (Appellant, hereafter), on August 14, 2003, and recorded by the Assignment Branch of the U.S. Patent and Trademark Office on September 4, 2003 (at Reel 014482, Frame 0830).

**II. RELATED APPEALS AND INTERFERENCES**

To the knowledge and belief of Appellant, the Assignee, and the undersigned, there are no other appeals or interferences before the Board of Appeals and Interferences that will directly affect or be affected by the Board's decision in the instant Appeal.

**III. STATUS OF CLAIMS**

The application was filed with claims 1-17. Claims 4-8 and 11-17 were withdrawn from consideration as of a Response to Restriction Requirement filed March 6, 2007 and canceled in an Amendment filed July 3, 2007. Thus, claims 1-3, 9 and 10 are the claims currently pending in the application.

Claims 1-3 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yap et al. (U.S. Publication 2001/0033736) (reference A of the PTO-892 part of paper no. 20070322) in view of Agnihotri et al. (U.S. Publication 2002/0081090) (reference B of the PTO-892 part of paper no. 20070322). Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Yap et al. in view of Agnihotri et al. as applied to claim 9 above, in further view of Kanemitsu, U.S. Patent 6,854,127 (reference C of the PTO-892 part of paper no. 20070322).

The rejections of claims 1-3, 9 and 10 are being appealed.

**IV. STATUS OF AMENDMENTS**

As of the Advisory Action dated December 20, 2007, no outstanding amendments to the claims are currently pending. Thus the claims stand as presented before the Final Office Action mailed September 12, 2007.

**V. SUMMARY OF THE CLAIMED SUBJECT MATTER**

The present invention relates to a method of recording a broadcasting program.

According to claim 1, disclosed is a method of preventing a duplicate recording of a broadcasting program, comprising:

extracting additional information from a digital broadcasting program<sup>1</sup> and recording the additional information separately in an additional information storage unit,<sup>2</sup> the additional information including title information and summary information;<sup>3</sup>  
before entering a recording mode, reading the additional information corresponding to a to-be-recorded broadcasting program from the additional information storing unit;<sup>4</sup>  
searching a recording unit and determining whether the recording unit stores title information corresponding to the to-be-recorded broadcasting program;<sup>5</sup>  
if the title information corresponding to the to-be-recorded broadcasting program is detected from the recording unit, comparing summary information included in the read

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<sup>1</sup> See Specification, page 8, lines 16-20.

<sup>2</sup> *Id.*

<sup>3</sup> *Id.* at page 6, line 14 - page 7, line 5.

<sup>4</sup> See FIG. 2, operation 202 and Specification, page 11, lines 6-11.

<sup>5</sup> See FIG. 2, operation 203 and Specification, page 11, lines 12-16.

additional information with that stored in the recording unit in connection with the detected title information, and then calculating a correspondence ratio;<sup>6</sup> and

comparing the calculated correspondence ratio with a predetermined reference value,<sup>7</sup> and if the correspondence ratio is less than the predetermined reference value, entering the recording mode to enable recording of the to-be-recorded broadcasting program on the recording unit.<sup>8</sup>

According to claim 9, disclosed is a method of preventing duplicate recording of a broadcasting program, comprising:

extracting additional information from a digital broadcasting program<sup>9</sup> and recording the additional information separately in an additional information storage unit,<sup>10</sup> the additional information including title information and summary information;<sup>11</sup> before executing a recording command, reading the additional information corresponding to a to-be-recorded broadcasting program from the additional information storing unit;<sup>12</sup>

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<sup>6</sup> See FIG. 2, operation 204 and Specification, page 12, lines 1-11.

<sup>7</sup> See FIG. 2, operation 205 and Specification, page 12, lines .12-15

<sup>8</sup> See FIG. 2, operation 206 and Specification, page 12, line 16 - page 13, line 2.

<sup>9</sup> See Specification, page 8, lines 16-20

<sup>10</sup> *Id.*

<sup>11</sup> *Id.* at page 6, line 14 - page 7, line 5.

<sup>12</sup> See FIG. 2, operation 202 and Specification, page 11, lines 6-11.

searching a recording unit and determining whether the recording unit stores title information corresponding to the to-be-recorded broadcasting program;<sup>13</sup> if the title information corresponding to the to-be-recorded broadcasting program is detected from the recording unit, ignoring the recording command.<sup>14</sup>

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<sup>13</sup> See FIG. 2, operation 203 and Specification, page 11, lines 12-16.

<sup>14</sup> See FIG. 2, operation 207 and Specification, page 13, lines 3-8.

**VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

Claims 1-3 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yap et al. (U.S. Publication 2001/0033736) (reference A of the PTO-892 part of paper no. 20070322) in view of Agnihotri et al. (U.S. Publication 2002/0081090) (reference B of the PTO-892 part of paper no. 20070322).

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Yap et al. in view of Agnihotri et al. as applied to claim 9 above, in further view of Kanemitsu, U.S. Patent 6,854,127 (reference C of the PTO-892 part of paper no. 20070322).

## VII. ARGUMENT

*Claims 1-3 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yap et al. (U.S. Publication 2001/0033736) (reference A of the PTO-892 part of paper no. 20070322) in view of Agnihotri et al. (U.S. Publication 2002/0081090) (reference B of the PTO-892 part of paper no. 20070322).*

Appellant respectfully submits that independent claim 1 would not be rendered obvious by the Examiner's proposed combination.

Claim 1 recites:

A method of preventing a duplicate recording of a broadcasting program, comprising:

extracting additional information from a digital broadcasting program and recording the additional information separately in an additional information storage unit, the additional information including title information and summary information;

before entering a recording mode, reading the additional information corresponding to a to-be-recorded broadcasting program from the additional information storing unit;

searching a recording unit and determining whether the recording unit stores title information corresponding to the to-be-recorded broadcasting program;

if the title information corresponding to the to-be-recorded broadcasting program is detected from the recording unit, comparing summary information included in the read additional information with that stored in the recording unit in connection with the detected title information, and then calculating a correspondence ratio; and

comparing the calculated correspondence ratio with a predetermined reference value, and if the correspondence ratio is less than the predetermined reference value, entering the recording mode to enable recording of the to-be-recorded broadcasting program on the recording unit.

Appellant respectfully submits that neither Yap nor Agnihotri discloses "extracting additional information from a digital broadcasting program and recording the additional information separately," as recited in claim 1. Yap discloses that an electronic program guide (EPG) containing program tag information may be searched by a user, and upon selection of a

program to record, tag information of previously stored programs are compared to the tag information of the selected program to determine if the program has been previously recorded. See paragraphs [0131]-[0133] of Yap. Thus, the tag information is not *extracted* from the program itself, but is provided by an outside source (the EPG). Agnihotri, on the other hand, discloses that transcripts for programs are obtained from a number of different sources of text, not extracted from the program itself. See abstract of Agnihotri. Thus, neither reference discloses “extracting additional information from a digital broadcasting program” as recited in claim 1.

The Examiner argues:

Yap teaches multiple recording units and recording the same information as the claimed invention. The only difference between the claimed invention and the applied references is that Yap records the information together and the claimed invention records it separately. A person of ordinary skill in the art would recognize that it would be a routine engineering choice to record information separately for a number of reasons such as accommodating memory capacity, and this modification could have been readily made to obtain predictable results. It is not patentable to use a known technique to improve a method otherwise disclosed in the prior art KSR v. Teleflex, 550 U.S. \_\_\_, 82 USPQ2d 1385 (Apr. 30, 2007).

Examiner respectfully submits that Yap is sufficient to teach the “extracting” step, as the claimed embodiments do not limit how or where the extracting occurs (such as extracting the information locally at each recording unit), and therefore read upon the “extracting” as disclosed in Yap.<sup>15</sup>

With regard to the Examiner’s citation to *KSR*, the citation fails to apply to a situation in which one of the elements of the claims is not disclosed, as in this application. Contrary to the Examiner’s statement “[t]he only difference between the claimed invention and the applied

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<sup>15</sup> See Advisory Action dated December 20, 2007, page 2.

references is that Yap records the information together and the claimed invention records it separately.”<sup>16</sup> Yap fails to disclose the extracting step, as noted above. Thus, the Examiner’s citation to *KSR* is misplaced, as the differences in the instant application and Yap are more than simply the recording of additional information.

Further, in Advisory Action comments, the Examiner still fails to indicate where Yap discloses *extracting* additional information from a digital broadcasting program. Rather, as noted on page 4 of the Response filed December 12, 2007, Yap discloses that the additional information is provided by an outside source (an electronic program guide (EPG)). The Examiner seems to argue that an extraction of additional information occurs at some time such that the information provided by the EPG is taken from the digital broadcasting program. However, Yap does not indicate that *any* extraction takes place. Yap does disclose *at best* that additional information may be sent along with a digital broadcasting program, but fails to disclose that the additional information is actually *extracted* from the digital broadcasting program. Therefore, Yap can at best only be read as being ambiguous with regard to extraction of additional information. However, ambiguities in the cited art must be construed against the Examiner.<sup>17</sup>

As noted above, Agnihotri, fails to disclose extracting additional information from the digital broadcasting program, as Agnihotri discloses that transcripts for programs are obtained

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<sup>16</sup> See Advisory Action dated December 20, 2007, page 2.

<sup>17</sup> See *In re Robertson*, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999).

from a number of different sources of text, not extracted from the program itself. See abstract of Agnihotri.

Therefore, the applied art, taken individually or in combination, discloses the extracting operation recited in claim 1, and claim 1 is patentable over the applied art. Claim 9 recites similar limitations to claim 1, and is patentable for reasons analogous to the above argument.

Further, claim 1 recites that both title information and summary information are used to identify duplicate programs. Yap, on the other hand, discloses only that “certain characteristics” are checked to determine if a match exists.<sup>18</sup> Yap further indicates that the characteristics may include the tag information.<sup>19</sup> However, there is no indication in Yap that *two separate* characteristics are used in determining if a duplicate program exists. Rather, Yap discloses only that if a match of the checked characteristic is found, then a notification provided to the user.<sup>20</sup> There is no indication that Yap discloses checking a first characteristic, determining a match, and checking a second characteristic for a match before entering recording mode. Therefore, again, Yap fails to disclose all of the elements of claim 1, and claim 1 is patentable over the applied art.

Claims 2 and 3, are patentable at least by virtue of their dependency from claim 1.

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<sup>18</sup> U.S. Patent Application Publication No. 2001/0033736 to Yap et al., paragraph [0133].

<sup>19</sup> *Id.* at paragraph [0134].

<sup>20</sup> Yap, at paragraphs [0133]-[0135].

**Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Yap et al. in view of Agnihotri et al. as applied to claim 9 above, in further view of Kanemitsu, U.S. Patent 6,854,127 (reference C of the PTO-892 part of paper no. 20070322).**

Claim 10 is dependent from claim 9. Because the proposed combination of Yap and Agnihotri fail to disclose all of the elements of claim 9, and because Kanemitsu fails to cure the defects noted in the Examiner's proposed combination, claim 10 is patentable at least by virtue of its dependency from claim 9.

**Conclusion**

The statutory fee was previously paid on March 14, 2008. The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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Date: April 16, 2008

**CLAIMS APPENDIX**

CLAIMS 1-3 and 9-10 ON APPEAL:

1. A method of preventing a duplicate recording of a broadcasting program, comprising:
  - extracting additional information from a digital broadcasting program and recording the additional information separately in an additional information storage unit, the additional information including title information and summary information;
  - before entering a recording mode, reading the additional information corresponding to a to-be-recorded broadcasting program from the additional information storing unit;
  - searching a recording unit and determining whether the recording unit stores title information corresponding to the to-be-recorded broadcasting program;
  - if the title information corresponding to the to-be-recorded broadcasting program is detected from the recording unit, comparing summary information included in the read additional information with that stored in the recording unit in connection with the detected title information, and then calculating a correspondence ratio; and
  - comparing the calculated correspondence ratio with a predetermined reference value, and if the correspondence ratio is less than the predetermined reference value, entering the recording mode to enable recording of the to-be-recorded broadcasting program on the recording unit.

2. The method of claim 1, wherein the title information includes sub-title information.
  3. The method of claim 1, further comprising producing a message informing that there is a broadcasting program already recorded in the recording unit, which broadcasting program may be identical to the to-be-recorded broadcasting program, when the correspondence ratio is greater than the predetermined reference value.
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9. A method of preventing duplicate recording of a broadcasting program, comprising:
    - extracting additional information from a digital broadcasting program and recording the additional information separately in an additional information storage unit, the additional information including title information and summary information;
    - before executing a recording command, reading the additional information corresponding to a to-be-recorded broadcasting program from the additional information storing unit;
    - searching a recording unit and determining whether the recording unit stores title information corresponding to the to-be-recorded broadcasting program;
    - if the title information corresponding to the to-be-recorded broadcasting program is detected from the recording unit, ignoring the recording command.

10. The method of claim 9, wherein the title information includes information on a sequence number of the to-be-recorded broadcasting program.

**EVIDENCE APPENDIX:**

Pursuant to 37 C.F.R. § 41.37(c)(1)(ix), submitted herewith are copies of any evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 or any other evidence entered by the Examiner and relied upon by Appellant in the appeal.

Appellant is not submitting any evidence.

**RELATED PROCEEDINGS APPENDIX**

Submitted herewith are copies of decisions rendered by a court or the Board in any proceeding identified about in Section II pursuant to 37 C.F.R. § 41.37(c)(1)(ii).

There are no copies of decisions rendered by a court or the Board to be submitted.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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In re application of

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Chun-Hee SONG

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Group Art Unit: 3628

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Examiner: Daniel VETTER

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For: METHOD AND APPARATUS FOR PREVENTING DUPLICATE RECORDING OF A  
BROADCASTING PROGRAM

**SUBMISSION OF AMENDED APPEAL BRIEF  
IN RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF**

**MAIL STOP APPEAL BRIEF - PATENTS**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In response to the Notice of Non-Compliant Appeal Brief, submitted herewith please find an Amended Appeal Brief. It is believed that no fee is due. However, the USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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